



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,110	08/10/2001	Victoria F. Dole	JBP-563	6271

27777 7590 07/09/2002
AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 07/09/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/928,110

Applicant(s)

DOLE ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change upon drying" renders the claim vague and indefinite. It is unclear whether the language is drawn to a process of making, or a structural limitation of the claimed composition.

The remaining claims are rejected as depending on indefinite base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neova product label in view of Gerstein (US 5139771).

Neova product label discloses silica-containing skin mask composition. The composition comprises water, silica, glycerin, polysorbate 20, and preservatives. Neova product label also discloses that silica in the composition absorbs excess oils while glycerin provides moisture to the skin. The composition is said to cleanse and provide skin fresh feel. See instant claims 12 and 13. The method of using the composition is also disclosed. See Directions; instant claim 11.

Neova fails to teach using colorant or the quantity of surfactants used.

Gerstein teaches skin-cleansing mask compositions. See abstract. The reference teaches to add colorants to "impart a pleasant color" to the composition. See col. 5, lines 27 – 33; instant claim 1. Example 5 employs FD & C green # 5, and all of the FD&C colors approved for cosmetic use and inorganic pigments are said to be suitable for the invention. While Gerstein does not disclose the recited colorants in instant claim 10, examiner takes the position that, in view of the general teaching in the reference, the difference in color is a mere preference of a skilled artisan and not a nonobvious selection over the prior art. See also Examples 4, 8, and 9 for the use of various colorants.

Gerstein further teaches that 0.1-7 % of surfactants, such as polysorbate 20, can be added in the compositions. See col. 4, line 52 – col. 5, line 14; col. 5, lines 43 – 64; see instant claims 5 and 6. Humectants such as glycerin (or glycerol) and moisturizer can be used up to 1.0 % and 3.0 %, respectively. See col. 4, lines 38 – 51; col. 5, lines 33 – 43; see instant claims 7-9. Using glycerin, propylene glycol, polyethylene glycol, and ethoxylated lanolin alcohols up to 2.0 % as plasticizer is also suggested. See col. 5, lines 17 – 21.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Neova mask composition by adding colorants, as suggested by Gerstein, because of the expectation of successfully producing a colored mask composition. While the combined references do not explicitly provide that the color changes as the composition dries, examiner notes that the color change is an inherent property of the prior art composition which otherwise meets the limitation of the instant claims, unless proven otherwise. See MPEP 2112.

All components in the instant claims are known. Nothing nonobvious or unexpected is seen in combining conventional ingredients well known in cosmetic art. See MPEP § 718.02.

2. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neova product label and Gerstein as applied to claims 1-10, 12, and 13 above, and further in view of Cabot Technical Data.

While Neova product label, discussed above, teaches that silica is effective in absorbing excess oil, as discussed above, the reference fails to disclose the type of silica used in the composition.

Cabot Technical Data teaches fumed silica useful in wide range of cosmetic products. The reference teaches that the fumed silica adsorbs excess oil on the skin. See p. 5, Powders.

It would have been obvious to a skilled artisan at the time the invention was made to have looked to the prior art such as Carbot Technical Data for a specific type of silica, and used the disclosed fumed silica therein in formulating the skin-cleansing mask composition of the combined references, Neova product label and Gerstein, because of the expectation of successfully producing a skin-cleansing mask that would be effective in removing excess oil.

3. Claims 1-4 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (US 5139782).

Jung teaches facial cleansing mineral composition comprising silica zeolite (silica molecular sieve). See abstract. The reference teaches that "colorants may be aesthetically desirable", while absence of colorants is acceptable as well. Jung further teaches to add polyols such as propylene glycol and sorbitol for conditioning the skin. See col. 4, lines 28 – 39.

While the reference does not explicitly provide that the color changes as the composition dries, examiner notes that the color change is an inherent property of the prior art composition which otherwise meets the limitation of the instant claims.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
July 1, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200